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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,402	04/08/2005	Karlheinz Horsting	DNAG-289	4886

24972 7590 08/31/2010  
FULBRIGHT & JAWORSKI, LLP  
666 FIFTH AVE  
NEW YORK, NY 10103-3198

EXAMINER
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HUDA, SAEED M

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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08/31/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyipdocket@fulbright.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/507,402	<b>Applicant(s)</b> HORSTING ET AL.	
	<b>Examiner</b> SAEED M. HUDA	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The response filed on 07/21/2010 has been fully considered and entered into the record.

### ***Specification***

2. Applicant states that the specification has been amended to overcome the objection to the alleged new matter. Applicant has removed the words “special” and “dyes”. Applicant has, hereby, overcome the objection to the specification.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-2 and 4-10 have been considered but are moot in view of the new ground(s) of rejection, to the extent that the arguments are applicable to the new grounds of rejection; they are addressed below.

Applicant states that Rohrbacher fails to disclose that a fiber-reinforced plastic material in the form of a mat or a polymer melt is applied onto a side of the preformed film that does not become the surface on the structural part. Rohrbacher states that SMC is used where SMC is a composition of reinforced thermosetting polymeric material such as cured polyester resin reinforced with fiber glass. This SMC would necessarily be in the form of a mat (column 1, lines 10-27).

Applicants also reiterate that Rohrbacher allegedly does not disclose a dyed layer as claimed. Rather, Rohrbacher discloses that the finished composite structure comprises an outer layer of a glossy clear thermoplastic coating firmly bonded to a layer of a thermoplastic pigment, which contains a paint which, in turn, is adhered to a thin

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size layer of a thermoplastic pigment, which, in turn, is adhered to the flexible thermoformable sheet of composite structure, column 2, lines 52 to 57. Figures 2 and 3 depict the layer sequences of the composite structures. Layer 4 is a paint coat or a pigmented coat which, with an adhesion layer 3, the thin layer is bonded to mat 2 of the composite structure. This layer is in fact dyed and Applicant has not provided sufficient evidence to show anything to the contrary.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 23-26 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohrbacher (US 4959189).

a. Regarding claim 23, Rohrbacher teaches fabricating a structural using fiber-reinforced plastic material that may be deformed by thermal molding comprising: placing a plastic film (3:22) which contains a pigmented layer (layer 4, interpreted to be a dyed layer, see 2:60) onto a mold (Fig. 5, item 18) which displays the topography of the surface of the structural part (4:33-44), deforming the film in conformance with the surface of the structural part (Fig. 5, items 18-20), and subsequently applying a fiber-reinforced plastic material using a process capable of applying that composition onto the backside. The context of the claim does not require any particular order of steps, and therefore this claim is

anticipated under 35 USC 102(b). In the alternative that the claims are meant to require that the deforming step be performed in the forming mold and that the fiber-reinforced plastic is subsequently applied also in the forming mold, then it is submitted that this is an obvious reordering of steps that would have been obvious to the ordinary artisan. Rohrbacher states that SMC is used where SMC is a composition of reinforced thermosetting polymeric material such as cured polyester resin reinforced with fiber glass. This SMC would necessarily be in the form of a mat (column 1, lines 10-27).

b. Regarding claim 24, in the Rohrbacher process, Rohrbacher suggests that a preformed film (20) is placed onto a forming mold of a molding press (Fig. 5, item 21), wherein the fiber-reinforced plastic material is in the form of a mat placed on the counterpiece of the molding press, and pressing to connect the pieces (Fig. 2, Fig. 5, arrow above 21). In the alternative, it would have been obvious to place the film on the other molding half in order to support the film prior to pressing it against the sheet molding compound.

c. Regarding claims 25-26, Rohrbacher provides a sheet molding compound (SMC, Abstract) which is either a thermosetting or thermoplastic material.

d. Regarding claim 29, Rohrbacher teaches that the transparent layer can be eliminated (6:30-35) and in doing so, suggests a pigmented or painted (dyed) top layer. The Examiner interprets this painted or finished surface to be a "special effect" dye since it colors the surface.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbacher (US 4959189) in view of Graefe (US 5074770).

Rohrbacher teaches the subject matter of Claim 23 above under 35 USC 102(b), or in the alternative, under 35 USC 103(a).

Regarding claim 27, Rohrbacher teaches a preformed sheet inserted into a mold (Fig. 5), a fiber mat placed under the cavity of the film, and the mold is closed until a resin hardens (4:49-51). Rohrbacher is silent to the injection of the resin. However, in a first view this is merely a rearrangement of prior art process steps since Rohrbacher teaches applying resin to fibrous material before placing the fibrous material in the mold. However, one would have found it obvious to apply the resin to the fibrous material at any point in the process. Additionally or alternatively, Graefe teaches a process in which a film is placed in a mold (Fig. 5, item 16), a fibrous layer is placed behind it (Fig. 5, item 30), and resin is injected after closing the mold (8:5-6). The injected resin contains a catalyst or initiator (13:10-15) which would act as a hardener when combined with the resin. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Graefe into that of Rohrbacher because (a) Rohrbacher clearly suggests that a combination of resin and fiber should

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be applied against the backside of a film, and Graefe provides a process for applying a resin and fiber material against the backside of a sheet, or (b) one of ordinary skill would have recognized the resin injection of Graefe as an obvious alternative or substitute for the use of a sheet molding material disclosed by Rohrbacher to provide the same result, namely a facing sheet with reinforced backing material.

8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbacher (US 4959189) in view of Furuya (US 6150026).

Rohrbacher teaches the subject matter of Claim 23 above under 35 USC 102(b), or in the alternative, under 35 USC 103(a).

Regarding claim 28, Rohrbacher does teach a three layer film comprising a color layer (Fig. 2, 6:31-32), however, Rohrbacher is silent to coextrusion. Furuya teaches that it is known to provide a film useful in an exterior panel by coextrusion lamination (col. 12) before performing the skin and molding material against the back surface. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Furuya into that of Rohrbacher since one of ordinary skill would have recognized the Furuya coextrusion process as a substitutable or alternative process for achieving or fabricating the film material to be preformed in the Rohrbacher process.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAEED M. HUDA whose telephone number is 571.270.5514. The examiner can normally be reached on 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571.272.1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KHANH NGUYEN/  
Primary Examiner, Art Unit 1791

/SAEED M. HUDA/  
Examiner, Art Unit 1791